

**REMARKS**

Claims 66, 71, 72, 75, 76, 78, 79, 83, 86, 91, 92, 94, 95, 97-100, and 106-125 are pending in the application and have been rejected by the Examiner. Applicant has amended claims 107, 113, 115, 117, 123 and 125 and canceled claim 124 in this response. The issues in the present Office Action are:

- Claims 66, 71, 72, 75-76, 78-79, 83, 86, 91, 92, 94, 95, 97-100, 106 and 125 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,952,638 to *Demers et al.* (hereinafter "*Demers*");
- Claims 106-124 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Demers* in further view of PCT publication number WO 96/01531 (hereinafter "*Vazvan '531*").

Claims 107, 113, and 117 have been amended in order to better define the process of identifying a geographic area by determining a particular cell. In claim 107, "location" was corrected to "locations." In claim 115, "occur" was changed to "occurs" to make the subject and verb agree. In claims 123 and 125 the word "centralized" has been added to modify "financial services application" to show that the customers and sellers are communicating to third parties. Dependent claim 124 has been canceled, and much of its wording has been incorporated into base claim 123.

**Improper Final Rejection.**

The Examiner improperly indicated that the current Office Action is final. An action may be made final in any second or subsequent action on the merits unless the Examiner introduces a new ground of rejection that is neither necessitated by amendment nor based on a correctly filed information disclosure statement. MPEP § 706.07(a).

In the present Office Action, Examiner introduced a new ground of rejection against all pending claims and has stated the new grounds of rejection were necessitated by applicant's amendments to the claims. Office Action at paragraph 6. However, Applicant did not amend all of the claims in the previous Amendment filed January 25, 2001.

Specifically, independent claims 95 and 106 were not amended in the January 25 Amendment.

The Office Action mailed October 25, 2000 rejected claims 95 and 106 in view of PCT publication number WO 97/45814 (hereinafter "*Vazvan '814*"). Applicant argued against these rejections, but did not amend the claims in the response filed January 25, 2001. The current Office Action introduced a new grounds of rejection (based on PCT publication number WO 96/01531 (*Vazvan '531*)) for claims 95 and 106. Applicant, therefore, respectfully asserts that the rejection was prematurely made final in view of this new grounds of rejection. See MPEP § 706.07 (a). Accordingly, Applicant requests that the Examiner withdraw the finality of the current Office Action and reconsider the pending claims.

**35 U.S.C. § 103(a) Rejections over *Demers***

Claims 66, 71, 72, 75-76, 78-79, 83, 86, 91, 92, 94, 95, 97-100, 106 and 125 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Demers*.

To establish a prima facie case of obviousness under 35 U.S.C. § 103(a), three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See MPEP § 2143. Applicant asserts that the cited reference does not teach or suggest all of the elements required by the pending claims, and, therefore, the claims are not obvious under 35 U.S.C. § 103(a).

***Demers* does not teach a correlation step**

Claim 66 requires:

correlating said identified customer with one or more of said plurality of transaction amounts that are associated with transactions in progress at the point of sale location.

Claim 86 requires:

means for correlating said identified customer with one or more of the plurality of transaction amounts that are associated with the not yet completed transactions.

Claim 106 requires:

correlating one or more of said customers to one or more of said transaction amounts.

*Demers* does not include the correlation step or means required in the present claims. It appears that the Examiner is equating the methods and systems for “initiating” and “controlling” a “transaction using a customer’s wireless device” in independent claims 66 and 86, respectively, with the electronic payment method of *Demers*. See *Demers*, col. 2, ln. 33 to 48. Applicant submits that the method and means for correlating the customer with one or more of the many transaction amounts, as required in the claims, are not taught in *Demers*. Instead, *Demers* teaches a system that operates by one-to-one communication between the customer and seller and between the seller and a bank or other financial institution. *Demers*, Figs. 1 and 4-7. No mention is made by *Demers* of a method or system to match up a seller and customer when there are many contemporaneous transactions.

The Office Action in paragraph 4 refers to “the use of the internet to deal with multiple parties simultaneously” and that this use is “well known.” Applicant traverses this assertion and respectfully request citation of a reference in support of Examiner’s position. See, MPEP § 2144.03. Moreover, even if the Internet is capable of dealing with multiple parties simultaneously, Applicant traverses the suggestion that the one-on-one wireless transactions of *Demers* can be combined with a general description of the Internet to provide the claimed invention.

The Examiner has merely alleged that it would have been obvious to use *Demers* to handle multiple customers simultaneously. Office Action at paragraph 4. However, the Examiner has provided no reasoning as to how such a modification to *Demers* could be accomplished. Moreover, the Examiner has not shown any motivation in the *Demers*

reference itself that would lead one of skill in the art to make such a modification. Therefore, the proposed modification is unacceptable under MPEP § 2143.01.

Applicant, therefore, respectfully submits that independent claims 66, 86, and 106 are patentable under 35 U.S.C. § 103(a) in view of the *Demers* reference.

Claims 71, 72, 75, 76, 78, 79, and 83 depend directly from base claim 66, and thereby inherit all of its limitations. Claims 91, 92, 94, 95, 97, 98, 99, and 100 depend directly from base claim 86, and thereby inherit all of its limitations. Thus, the Applicant respectfully submits that claims 71, 72, 75, 76, 78, 79, 83, 91, 92, 94, 95, 97, 98, 99, and 100 are also patentable over the 35 U.S.C. § 103(a) rejection of record.

***Demers* Does Not Teach a Call to a Centralized Financial Services Application.**

Claim 125, as amended, requires:

initiating a call to a centralized financial services application.

*Demers* teaches a method wherein the customer contacts the seller directly, and then the seller contacts a bank. *Demers*, col. 2, ln. 33-48, and Figures 1 and 4-7. The user in *Demers* is not connected to a centralized financial services application as required by claim 125. *Demers* teaches away from a centralized financial services application. Instead, *Demers* teaches a system in which transactions are performed “off-line” of a bank or centralized financial services application. *Demers*, col. 2, ln. 29-33. Accordingly, *Demers* does not teach or suggest using a centralized financial services application to complete transactions.

*Demers* does not teach each and every element of claim 125. Applicant, therefore, respectfully asserts that for the above reasons independent claim 125 is patentable under 35 U.S.C. § 103(a) in view of the cited reference.

**Rejections over the *Demers/Vazvan* combination**

Claims 106-124 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Demers* in further view of *Vazvan* ‘531.

**There is no motivation or suggestion to combine *Vazvan* and *Demers*.**

There must be motivation to combine or modify references to establish obviousness. MPEP § 2143. If the proposed combination changes the principle of operation of a reference, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. See MPEP §2143.01 and *In re Ratti*, 123 USPQ 349 (CCPA 1959).

One of the principles of *Demers* is to provide a spatially and computationally efficient method to complete microtransactions. Usually the transactions will occur off-line in order to cut down on memory used and computations done by the customer and the seller. *Demers*, col. 1, ln. 36 to 42.

*Vazvan '531* is a cellular tracking device that may continuously determine speed and position of a mobile terminal. Page 2, ln. 10 to 16. The *Vazvan '531* system requires constant measurements by three or more cellular base stations that are in communication with the user's mobile device. *Vazvan '531*, Page 3 ln.17 to 22.

*Vazvan '531* requires that the wireless device be in constant communication with multiple base stations, which is incompatible with the system in *Demers*. The *Demers* system seeks to communicate as little as possible with other devices so that memory and computational requirements are kept to a minimum. Moreover, there is no suggestion in *Demers* to modify the system to ever communicate with more than one point of sale location, or base station, at one time. To combine *Vazvan '531* with *Demers* changes the efficiency principle of *Demers*; therefore, the combination is improper, and the claims are not obvious to one of ordinary skill in the art.

The principle of computational and spatial efficiency set forth in *Demers* is not served by combining that system with the constant communication and computation set forth in *Vazvan '531*. Applicant, therefore, respectfully asserts that claims 106-123 are patentable under 35 U.S.C. § 103(a) in view of the proposed combination.

**The *Demers/Vazvan* combination does not teach or suggest a correlation step.**

Claim 106 includes limitations not taught or suggested by the *Demers/Vazvan* combination, and therefore, claim 106 is patentable under 35 U.S.C. § 103(a) in view of the cited references.

Claim 106 requires:

correlating one or more of said customers to one or more of said transaction amounts;

As discussed above, *Demers* does not teach or suggest a correlation element. *Vazvan '531* also fails to teach or suggest this element. Instead, *Vazvan '531* is a cellular positioning system that determines a mobile terminal's geographic location, and does not include a requirement of correlating one or more customers with one or more transaction amounts. See *Vazvan '531* Abstract and page 8, ln. 19 - page 9, ln. 30. The correlation step is not taught or suggested by *Demers* nor *Vazvan '531*, and, therefore, the combination of *Demers/Vazvan* cannot teach or suggest a step to correlate one or more customers with one or more transaction amounts. Accordingly, Applicant respectfully submits that independent claim 106 is patentable under 35 U.S.C. § 103(a) in view of the cited combination.

**The *Demers/Vazvan* combination does not teach selecting a point of sale location.**

Claim 107 requires:

if only one of said point of sale locations is within said geographic area, then communicating financial data for said point of sale location to said customer's wireless device over said wireless network; and

if more than one of said point of sale locations are within said geographic area, then prompting said customer to select a point of sale location from a list of said point of sale locations within said geographic area, and communicating financial data for a selected point of sale location to said customer's wireless device over said wireless network.

Independent claim 107 requires the step of prompting the customer to select a point of sale and communicating the financial data from the selected point of sale to the customer's wireless device. *Demers* does not teach or suggest that the customer can choose the point of sale location from a list. *Vazvan '531* provides no discussion of transactions and, therefore,

also fails to teach or suggest this element. Therefore, the *Demers/Vazvan* combination does not teach or suggest this step. Accordingly, claim 107 is not obvious under 35 U.S.C. § 103(a) in view of the *Demers/Vazvan* combination because the combination does not teach or suggest every limitation.

Dependent claim 109 further requires:

causing said customer's wireless device to display a list of said point of sale locations within said geographic area; and  
receiving information from said customer's wireless device identifying said selected point of sale location.

Dependent claim 110 further provides:

playing a voice message to said customers via said wireless device,  
wherein said voice message comprises a list of said point of sale locations; and  
receiving information from said customer's wireless device identifying said selected point of sale location.

Dependent claims 109 and 110 further require that the customer is prompted to select a point of sale, and the financial data from the selected point of sale is communicated to the customer's wireless device. As noted above, *Demers* does not teach or suggest this step. *Vazvan '531* also fails to teach or suggest this step. Therefore, the *Demers/Vazvan* combination does not teach or suggest this step. Accordingly, claims 109 and 110 are not obvious in view of the *Demers/Vazvan* combination because the combination does not teach or suggest every limitation.

Claim 113 requires:

determining a particular point-of-sale location that is selected by the user for a desired transaction; and  
obtaining transaction amounts for one or more transactions at said particular point-of-sale location.

Claim 117 requires:

means for determining a particular point-of-sale location that is selected by the user for a desired transaction; and

means for receiving transaction amounts for one or more transactions at said particular point-of-sale location.

Claims 113 and 117 require a step or means for determining a point-of-sale location based on the customer's choice. As noted above, *Demers* does not teach or suggest this step. *Vazvan '531* has nothing to do with transactions and, therefore, also fails to teach or suggest this step. Accordingly, the *Demers/Vazvan* combination does not teach or suggest this step. As a result, claims 113 and 117 are not obvious in view of the *Demers/Vazvan* combination because the combination does not teach or suggest every limitation.

Claims 108-112 depend directly from base claim 107 and thereby inherit all of its limitations. Claims 114-116 depend directly from base claim 113 and thereby inherit all of its limitations. Claims 118-122 depend directly on claim 117 and thereby inherit all of its limitations. Thus, Applicant respectfully asserts that for the above reason, claims 108-112, 114-116, and 118-122 are also patentable 35 U.S.C. § 103(a) in view of the cited reference.

**The *Demers/Vazvan* combination does not teach location using a single cell.**

Claim 107, as amended, requires:

said identifying step accomplished by determining a specific wireless cell that is in communication with said customer's wireless device.

Claim 113, as amended, requires:

the current location of the wireless device is determined by identifying a current cell of said wireless network that is in communication with the wireless device.

Claim 117, as amended, requires:

the current location of the wireless device is determined by identifying a current cell of said wireless network that is in communication with the wireless device.

Claim 123, as amended, requires:



identifying a current location of the user by determining a current wireless network cell that is in communication with the user's wireless device; and

transmitting a list of transaction locations to be displayed to the user via the wireless device, wherein said list of transaction locations is selected from a user profile that has been configured by the user prior to initiating a transaction and is selected based upon the user's current location.

The elements required in the pending claim are not taught or suggested by the *Demers/Vazvan* combination. The Examiner has admitted that *Demers* does not teach locating. Office Action at page 3. *Vazvan '531* also fails to teach or suggest the required element of locating the wireless device using a current cell. Instead, *Vazvan '531* requires that the device be in current contact with three or more cellular base stations to pinpoint the exact location and speed of a mobile cellular device. Page 3 ln.17 to ln. 22. The present invention, in amended claims 107, 113, 117, and 123, requires a current cell to determine the location of the wireless device. Applicant, therefore, respectfully asserts that independent claims 107, 113, 117, and 123 are patentable under 35 U.S.C. § 103(a) in view of the cited combination.

Claims 108-112 depend directly from base claim 107, and thus inherit all of its limitations. Claims 114-116 depend directly from base claim 113, and thus inherit all of its limitations. Claims 118-122 depend directly on claim 117, and thus inherit all of its limitations. Thus, Applicant respectfully asserts that for the above reason, claims 108-112, 114-116, and 118-122 are also patentable over the 35 U.S.C. § 103(a) rejection of record.

***Demers/Vazvan* does not teach connections to a centralized financial services application.**

Claim 123, as amended, requires:

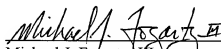
connecting a user to a centralized financial services application via a wireless network.

Independent claim 123 requires the steps of connecting a user to a centralized financial services application. *Demers* teaches a method wherein the customer contacts the

seller directly only, and then the seller contacts a bank. *Demers*, col. 2, ln. 33 to 48 and Figs. 1 and 4-7. The user in *Demers* is not connected to a centralized financial services application as required by claim 123. Indeed, *Demers* teaches away from the centralized financial services application of claim 123. *Demers* teaches a system in which transactions are performed "off-line" of a bank or centralized financial services application. *Demers*, col. 2, ln. 29-33. There is no suggestion in *Demers* to use a centralized financial services application to complete the transaction. *Vazvan '531* also fails to teach or suggest this element, and therefore, the cited combination does not teach or suggest every element. Accordingly, Applicant respectfully asserts that independent claim 123 is patentable under 35 U.S.C. § 103(a) in view of the cited reference.

Applicant respectfully requests that the Examiner call the below listed attorney if the Examiner believes that a discussion would be helpful in resolving any remaining problems.

Respectfully submitted,

  
\_\_\_\_\_  
Michael J. Fogarty, III  
Registration No. 42,541  
Counsel for Applicant

Date: 6/28/01

Fulbright & Jaworski L.L.P.  
2200 Ross Avenue, Suite 2800  
Dallas, Texas 75201-2784  
Telephone: 214-855-8172  
Telecopier: 214-855-8200

**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

107. (Amended) A method for processing financial data, wherein said financial data relates to customer transactions at point of sale locations and wherein said customers have wireless devices that are in communication with a wireless network, said method comprising the steps of:

- receiving financial data from a plurality of point of sale locations;
- identifying a geographic area for a customer who has initiated a transaction using a wireless device, said identifying step accomplished ~~at least in part~~ by determining a specific wireless cell that is in communication with said customer's wireless device; and
- determining which of said plurality of point of sale locations are within said geographic area;

- if only one of said point of sale ~~locations~~ ~~location~~ is within said geographic area, then communicating financial data for said point of sale location to said customer's wireless device over said wireless network; and

- if more than one of said point of sale locations are within said geographic area, then prompting said customer to select a point of sale location from a list of said point of sale locations within said geographic area, and communicating financial data for a selected point of sale location to said customer's wireless device over said wireless network.

113. (Amended) A method for controlling transactions using a wireless device in a wireless network comprising the steps of:

displaying point-of-sale locations to a user via one or more menus on the wireless device, the menus listing at least one point-of-sale location based upon a current location of the wireless device, wherein the current location of the wireless device is determined ~~at least in part~~ by identifying a current cell of said wireless network that is in communication with the wireless device, and the menu display configured according to a user profile that is created by the user so that only information identified in the user's profile is listed on the menu;

determining a particular point-of-sale location that is selected by the user for a desired transaction;

obtaining transaction amounts for one or more transactions at said particular point-of-sale location;

correlating one of said transaction amounts with the user's desired transaction;

transmitting the correlated transaction amount to the wireless device for display to the user; and

charging the correlated transaction amount to a source of funds identified by the user to allow completion of the desired transaction.

115. (Amended) The method of claim 113 wherein the users identify potential sources of funds before the desired transaction ~~occurs~~ occurs by configuring a user profile.

117. (Amended) A system for processing financial data, wherein the financial data relates to transactions by customers at point of sale locations and wherein said customers have wireless devices that are in communication with a wireless network, the system comprising:

means for displaying point-of-sale locations to a user via one or more menus on the wireless device, the menus listing at least one point-of-sale location based upon a current location of the wireless device, wherein the current location of the wireless device is ~~determined at least in part~~ by identifying a current cell of said wireless network that is in communication with the wireless device, and the menu display configured according to a user profile that is created by the user so that only information identified in the user's profile is listed on the menu;

means for determining a particular point-of-sale location that is selected by the user for a desired transaction;

means for receiving transaction amounts for one or more transactions at said particular point-of-sale location;

means for correlating one of said transaction amounts with the user's desired transaction;

means for transmitting the correlated transaction amount to the wireless device for display to the user; and

means for charging the correlated transaction amount to a source of funds identified by the user to allow completion of the desired transaction.

123. (Amended) A method for completing a financial transaction using a wireless device comprising:

connecting a user to a centralized financial services application via a wireless network;

identifying a current location of the user by determining a current wireless network cell that is in communication with the user's wireless device;

transmitting a list of transaction locations to be displayed to the user via the wireless device, wherein said list of transaction locations is selected from a user profile that has been configured by the user prior to initiating a transaction and is selected based upon the user's current location;

receiving a transaction location selection from the user;

transmitting a list of point-of-sale terminals to be displayed to the user via the wireless device, wherein the point-of-sale terminals are located at the selected transaction location;

receiving a point-of-sale selection from the user;

transmitting a transaction amount to be displayed to the user via the wireless device, wherein the transaction amount is associated with the selected point-of-sale terminal;

prompting the user to accept or reject the displayed transaction amount; and

authorizing a financial transaction for the transaction amount at the point-of-sale terminal.

125. (Amended) A method for processing a financial transaction using a wireless device comprising:

- initiating a call to a centralized financial services application;
- selecting a desired type of product or service from a first list displayed on the wireless device, wherein the list of products and services are selected from a user profile associated with the wireless device;
- selecting, from a second list displayed on the wireless device, a location where the selected type of product or service is offered;
- selecting a particular point-of-sale terminal at the selected location;
- receiving a transaction amount that is associated with the point-of-sale terminal, wherein the transaction amount is displayed on the wireless device; and
- completing the financial transaction by approving the displayed transaction amount.